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PRE-APPEAL BRIEF REQUEST FOR REVIEW

3691-583

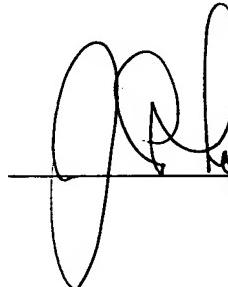
	Application Number 10/645,836	Filed August 22, 2003
	First Named Inventor LINGLE	
	Art Unit 1755	Examiner G. BLACKWELL

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.



Signature
Joseph A. Rhoa

I am the

- Applicant/Inventor
- Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)
- Attorney or agent of record 37,515
(Reg. No.)
- Attorney or agent acting under 37CFR 1.34.
Registration number if acting under 37 C.F.R. § 1.34 _____

Typed or printed name

703-816-4043

Requester's telephone number

April 13, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

- *Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

LINGLE et al.

Atty. Ref.: 3691-583; Confirmation No. 8131

Appl. No. 10/645,836

TC/A.U. 1755

Filed: August 22, 2003

Examiner: G. BLACKWELL

For: COATED ARTICLE WITH SILICON NITRIDE INCLUSIVE LAYER ADJACENT
GLASS

* * * * *

April 13, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to the OG Notice of July 12, 2005, applicant hereby requests a pre-appeal brief review of this case for at least the following reasons.

Claim 1 stands rejected under 35 U.S.C. Section 102(b) as being allegedly anticipated by Krisko (US 6,060,178). This Section 102(b) rejection is respectfully traversed for at least the following reasons.

Claim 1 requires that “the coated article is heat treated and has *a ratio T_{vis}/R_s of at least 25 after heat treatment (where T_{vis} is visible transmission (%) and R_s is sheet resistance of the coating in units of ohms/square) and a ΔE^* value (glass side reflective and/or transmissive) of less than or equal to about 8 due to the heat treatment.*” Krisko fails to disclose or suggest this feature of amended claim 1.

Krisko fails to disclose or suggest the coating of claim 1, having *a ratio T_{vis}/R_s of at least 25 after heat treatment and a ΔE^* value of less than or equal to about 8 due to the heat treatment.* Krisko does not expressly state what the T_{vis}/R_s and ΔE^* values are for Example 2 which is relied on by the Examiner in the final rejection. However, viewing Krisko as a whole evidences that values of Krisko's Example 2 do *not* necessarily fall within the ranges of claim 1. Example 1 of Krisko has a T_{vis}/R_s of 17.8 after heat treatment, which is *well less than that required by claim 1.* Because Example 2 of Krisko has a *lower* visible transmission (T_{vis}) after heat treatment than does Example 1 of Krisko (82% in Example 2 vs. 89% in Example 1), this factor would suggest that the T_{vis}/R_s value of Example 2 relied on in the final rejection would be even *lower* than the 17.8 value of Example 1 and thus be even further outside of the range called for in claim 1. Accordingly, it is respectfully submitted that the evidence of record shows that Krisko's Example 2 does not necessarily fall within the ranges of claim 1.

Furthermore, the law is clear that for something to be "inherent" in a reference, it must "necessarily" be present. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The fact that a certain result or characteristic "may" occur or be present in the prior art is not sufficient to establish the inherence of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). In this case, there is nothing in Example 2 of Krisko which discloses or suggests any of the values T_{vis}/R_s and ΔE^* recited in claim 1. Moreover, Example 1 of the same Krisko reference suggests that these values are not present in Example 2. Thus, it is respectfully submitted that there is no reasonable basis for an "inherence" rejection of claim 1. The Board of Appeals has made clear that "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows

from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Such a showing cannot be made in this case given that the cited art (e.g., Krisko’s Example 1) actual suggests to the contrary.

Ebisawa (US 6,472,072), Rondeau (US 6,355,334) and Laird (US 2003/0150711) also fail to disclose or suggest *a ratio T_{vis}/R_s of at least 25 after heat treatment and a ΔE^* value of less than or equal to about 8 due to the heat treatment* as required by claim 1. Thus, these references also do not meet or suggest the invention of claim 1, either alone or in combination. Again, there is no reasonable basis for the Examiner to allege that these features of claim 1 are met from these references.

Ebisawa at col. 7, lines 40-50, for example has drastic swings in a* and b* color values in Example 1 (relied on by the Examiner) due to heat treatment thereby suggestion a ΔE^* value well above the range called for in claim 1. While Example 1 of Ebisawa does not have sufficient information to calculate T_{vis}/R_s , this value in Example 3 of Ebisawa (TL/TS, using values at col. 10, lines 10-17 after heat treatment) was 13.06 which is *well outside* of the range called for in claim 1. Example 4 of Ebisawa had a T_{vis}/R_s of 12.59, again well outside of the range called for in claim 1. Again, the fact that the Examples of Ebisawa which had enough information to calculate T_{vis}/R_s all had such values well outside of the range called for in claim 1 evidences that these values are also not met by Example 1 which is silent in this regard and relied on by the Examiner.

Rondeau only has one layer comprising silver, and is thus unrelated to claim 1 for this additional reason. In addition, Rondeau gives no T_{vis} or R_s or a* or b* or L* values following heat treatment so that the reference cannot possibly disclose or suggest the claimed T_{vis}/R_s and ΔE^* values of claim 1.

Laird's coated article is designed to be non-heat treated. Again, it is entirely unrelated to the invention of claim 1. The reference gives no T_{vis} or R_s or a^* or b^* or L^* values following heat treatment (because Laird is directly toward a non-heat-treated product) so that the reference cannot possibly disclose or suggest the claimed T_{vis}/R_s and ΔE^* values of claim 1. Hindsight is not permissible. Citation to Hartig cannot cure the aforesaid flaws of Laird (moreover, Hartig's coating is unrelated to that of claim 1).

Claim 23 requires the coated article is heat treated and has a *ratio T_{vis}/R_s of at least 34 after heat treatment* and a *ΔE^* value of less than or equal to about 8* due to the heat treatment. Again, each of Krisko, Ebisawa, Rondeau and Laird fail to disclose or suggest this requirement of claim 23. Citation to Hartig cannot cure the fundamental flaws of Laird in this regard.

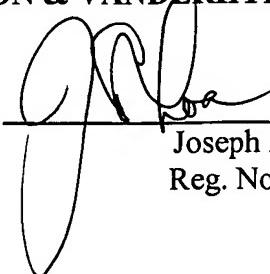
Claim 39 requires the coated article is heat treated and has a *ratio T_{vis}/R_s of at least 32 after heat treatment* and a *ΔE^* value of less than or equal to about 8* due to the heat treatment. Again, each of Krisko, Ebisawa, Rondeau and Laird fail to disclose or suggest this requirement of claim 39. Citation to Hartig cannot cure the fundamental flaws of Laird in this regard.

It is respectfully requested that all rejections be withdrawn. All claims are in condition for allowance. If any minor matter remains to be resolved, the Examiner is invited to telephone the undersigned with regard to the same.

Respectfully submitted,

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